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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,879	03/09/2007	Steve Arscoff	1034404-000002	5040
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EXAMINER				
CHANG, HANWAY				
ART UNIT		PAPER NUMBER		
2881				
NOTIFICATION DATE		DELIVERY MODE		
06/17/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/578,879

Applicant(s)

ARSCOTT ET AL.

Examiner

Hanway Chang

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date 05/11/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-9, 11-14, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Zimmermann et al. (US Pat. 6,602,472, hereinafter Zimmermann).

Regarding claim 1, Fig. 4a of Zimmermann discloses an electrospray source (50) having at least one flat and thin tip (47) (see col. 6, lines 28-31) in cantilever in relation to the rest of the structure, the tip (57) being provided with a capillary slot (56) (see col. 6, lines 28-31) formed through the complete thickness of the tip and which ends up at the end of the tip (57) to form the ejection orifice of the electrospray source, the source comprising means of supplying (55) the capillary slot (56) with liquid to be nebulised and means of applying an electrospray voltage to the liquid (see col. 6, lines 28-37). It should be noted that the device must be

Regarding claim 2, Fig. 4a of Zimmermann discloses the supply means comprises at least one reservoir (55) in fluidic communication with the capillary slot (56) (see col. 6, lines 28-37).

Regarding claim 3, Fig. 4a of Zimmermann discloses the structure comprises a wafer (50) which a part constitutes the tip (57) (see col. 6, lines 11-43). Zimmermann does not explicitly disclose a support. However, a support must inherently be present in any device which holds the source in place.

Regarding claims 4 and 13, Fig. 4a of Zimmermann discloses the supply means comprises a reservoir (55) constituted by a recess formed in the wafer (50) and in fluidic communication with the capillary slot (56) (see col. 6, lines 34-37). It should be noted that although Zimmermann does not explicitly recite a recess or an equivalent term, the reservoir (55) is used to hold a liquid to be microsprayed, which inherently must have a recess of some form.

Regarding claims 5 and 14, Fig. 4a of Zimmermann discloses at least one electrode (57) arranged so as to be in contact with the liquid to be nebulised (see col. 6, lines 28-37). It should be noted that in order for the liquid to be sprayed as disclosed above, a means of applying a voltage must inherently be present.

Regarding claim 6, Fig. 4a of Zimmermann discloses that the wafer is at least partially electrically conductive (see col. 6, lines 31-34).

Regarding claim 8, Fig. 4a of Zimmermann discloses the supply means comprises a capillary tube (56) (see col. 6, lines 28-31).

Regarding claim 9, Fig. 4a of Zimmermann discloses the supply means comprises a channel (51) formed in a microsystem supporting the structure and in fluidic communication with the capillary slot (56) (see col. 6, lines 18-31).

Regarding claim 11, Fig. 4a of Zimmermann discloses the formation of the support from a substrate, formation of a wafer (50) having a part constituting a flat and thin tip (57), the tip being provided with a capillary slot (56) to convey a liquid to be nebulised, formed in the complete thickness of the tip and which ends up the end of the tip, and making the wafer (50) integral on the support, the tip (57) being in cantilever in relation to the support (see col. 6, lines 11-43).

Regarding claim 12, Fig. 4a of Zimmermann discloses providing the substrate (50) to form the support, the delimitation of the support by means of trenches etched in the substrate, deposition, on a zone of the substrate corresponding to the future tip (57) of the structure, of sacrificial material according to a determined thickness, the deposition of the wafer on the support delimited in the substrate, the tip (57) of the wafer being situated on the sacrificial material, the elimination of the sacrificial material, and the detachment of the support in relation to the substrate by cleavage at the level of the trenches (see col. 6, lines 11-43).

Regarding claim 19, Fig. 4a of Zimmermann discloses electrospraying the liquid and analyzing the liquid by mass spectrometry (see col. 6, lines 31-34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmermann.

Regarding claim 7, Fig. 4a of Zimmermann discloses that the tip (57) microsprays the liquid (see col. 6, lines 31-34). It was obvious at the time of invention to a person of ordinary skill in the art that electro spray is done by applying a voltage to the tip to charge the liquid to force the liquid through the tip and disperse into a mist or nebula. Therefore, it would have been obvious to have an electrically conductive wire supply the required energy to the tip to perform the above function.

Regarding claim 20, Fig. 4a of Zimmerman discloses the claimed invention except for controlling the size of the liquid spray. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Zimmermann by varying the voltage source applied to the tip to vary the size of the formed droplets, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claims 21 and 22, the limitations "carrying out molecular writing" and "define the electrical junction potential of a device" are merely a functional/intended use

limitation that does not structurally distinguish the claimed invention over the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmermann in view of Schultz et al. (US Pat. 6,633,031, hereinafter Schultz).

Regarding claim 10, a difference between Zimmerman and the claimed invention is the wafer has a surface hydrophobic to the liquid to be nebulised. However, in the same field of endeavor, Schultz discloses the use of a hydrophobic coating on a microchip to improve stability in the process of electrospray (see col. 8, lines 26-43). In view of such teaching, it would have been obvious to the ordinary artisan at the time the invention was made to modify the invention of Zimmermann by having a hydrophobic coating on the wafer for the purpose of improving stability during the electrospray process as taught by Schultz.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanway Chang whose telephone number is (571)270-5766. The examiner can normally be reached on Monday to Friday 7:30 AM till 4 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H. Kim can be reached on (571)272-2293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hanway Chang
June 10, 2009
/H. C./
Examiner, Art Unit 2881

/ROBERT KIM/
Supervisory Patent Examiner, Art Unit 2881